

Applic. No. 09/848,583
Amdt. dated February 27, 2007
Reply to Office action of November 27, 2006

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Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-4 and 6-11 remain in the application. Claim 10 has been amended. Claims 5, 12, and 13 were previously cancelled. Claim 11 has been withdrawn from consideration.

Claim 10 has been amended to replace the term "memory-programmed controller" with "programmable logic controller". Support for the amendment to the claim is based on the following. The term "memory-programmed controller" was used as a translation of the German term "speicherprogrammierbare Steuerung". The term "speicherprogrammierbare Steuerung" was used in the German patent application No. 10 21 449.5, filed May 3, 2000. Provision for amending the claim 10 to include the proper translation of "speicherprogrammierbare Steuerung" is given under MPEP 201.13. Also, an attachment from PC Bibliothek is provided herewith, the attachment shows the English translation of the German term "speicherprogrammierbare Steuerung". Accordingly, no new matter has been added.

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In item 3 on pages 3-4 of the above-mentioned Office action, claims 1-4, 6, 7, and 10 have been rejected as being anticipated by Ito (US 4,922,773) under 35 U.S.C. § 102(b).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

the first drive and the second drive being embodied as separate, mutually independent drives, and both of the drives being connected to one another via a control system for setting the course of motion of the transport device to the knife motion as a function of product format.

On page 2 of the Office action, the Examiner states that Ito discloses "a stroke device (14 and 24) for moving knives (13 and 23) in a knife motion for performing the trimming of the margins".

Ito discloses that the reference symbol 14 and 24 are "holders" for the knives (column 1, lines 30-32). Ito does not disclose stroke devices. Ito does disclose connecting

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rods (not numbered). One connecting rod is connected to the cutting unit (10) and to meshing pinions, and the other connecting rod is connected to the retaining element of knife (49) and to the meshing pinions. The meshing pinions are presumably connected to the drive mechanism, which is not shown. Ito does not disclose the construction of the drive mechanism.

The Examiner alleges on page 2 of the Office action, that Ito discloses "and both drives being connected to the other via a control system for setting the course of motion of the transport device to the knife motion as a function of product format."

The Examiner alleges on page 4 of the Office action that Ito discloses "item 57 and drive mechanism are clearly independent drive inherently controlled by item 70."

Applicants respectfully disagree with the Examiner's allegations. More specifically, the drive mechanism is not controlled by item (70). Figure 6 of Ito explicitly discloses that the control unit (70) controls the motors (20, 36, 47, and 57). Ito does not disclose that the control unit (70) controls the "drive mechanism" (not shown).

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MPEP § 2112 (8th edition, 1st revision) states that:

**EXAMINER MUST PROVIDE RATIONALE OR
EVIDENCE TENDING TO SHOW INHERENCY**

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

As discussed in MPEP § 2112, a limitation recited in a claim that is not expressly or implicitly disclosed in a prior art reference is inherently disclosed therein if, and only if, the "missing" limitation is **necessarily present** in the prior art, and that it would be so **recognized by persons of ordinary skill**. The principles of inherency require that the inherency be **absolute**, and not probabilistic. As far as applicants were able to ascertain, there is no disclosure or suggestion in Ito that it is **absolutely necessary** that the drive mechanism be controlled by the control unit (70).

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Furthermore, according to a sub-heading in MPEP § 2112, the "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY", i.e. the Examiner has the burden of proof (by a preponderance of the evidence) to show that Ito necessarily disclose or suggest purposefully the drive mechanism is controlled by the control unit (70). Instead of offering factual evidence disclosing or suggesting drive mechanism is controlled by the control unit, in the context of the present invention, the Examiner made a statement without any factual support or Official Notice. The Examiner cannot simply be the devil's advocate postulating certain results or processes that may or may not occur or be present in the applied prior art and leave it up to Applicants to show or prove the contrary.

Moreover, in several telephone conversations with the Examiner's supervisor (Boyer Ashley), Examiner Ashley indicated that the Examiner's allegations regarding the drives and the control unit disclosed in Ito did not appear to be accurate. Furthermore, Examiner Ashley indicated that any possible further Office action would be given considerable scrutiny to ensure the accuracy thereof.

As seen from the above-given remarks, it is respectfully noted that the Examiner's allegations pertaining to the drives and the control unit of Ito, are not accurate.

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As seen from the above-given remarks, the reference does not show the first drive and the second drive being embodied as separate, mutually independent drives, and both of the drives being connected to one another via a control system for setting the course of motion of the transport device to the knife motion as a function of product format, as recited in claim 1 of the instant application.

In item 5 on page 4 of the above-mentioned Office action, claims 8-9 have been rejected as being unpatentable over Ito in view of Cannon et al. (US 4,553,080) (hereinafter "Cannon") under 35 U.S.C. § 103(a). Cannon does not make up for the deficiencies of Ito. Since claim 1 is believed to be allowable, dependent claims 8 and 9 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

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In view of the foregoing, reconsideration and allowance of
claims 1-4 and 6-11 are solicited.

In the event the Examiner should still find any of the claims
to be unpatentable, counsel respectfully requests a telephone
call so that, if possible, patentable language can be worked
out.

If an extension of time for this paper is required, petition
for extension is herewith made.

Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner
Greenberg Stemer LLP, No. 12-1099.

Respectfully submitted,


For Applicant(s)

Alfred K. Dassler
52,794

AKD:cgm

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Lerner Greenberg Stemer LLP
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101

speicherprogrammierbare Steuerung f (TSPS) KONTROLL, REGELUNG programmable
logic control (PLC)